

- (b) The Office Action rejected claims 1-4, 6-11 and 13-15 under 35 USC § 103 as being unpatentable over McDonald in view of Ryan. Applicant traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.³

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

McDonald is non-analogous prior art. The reference is not within the field of the inventor's endeavor.⁴ Applicant's field of endeavor is doors for air handling units. Air handling units are classified by the Office in U.S. Class 52, subclass 79, as exemplified by U.S. Patent No. 3,818,655. PTO Classification is some evidence of analogousness.⁵ McDonald is classified in U.S. Class 52, subclass 309.9. McDonald's field of endeavor is small, pre-fabricated buildings with insulated, fiberglass walls. See Field of Invention, Description of Related Prior Art. The test for analogous art outside an inventor's field of endeavor is whether the art pertains

¹MPEP Sec. 2142.

² Id.

³Id. (emphasis supplied)

⁴*In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

⁵ Id.

to the particular problem confronting the inventor.⁶ In these situations, the law presumes knowledge only of those arts reasonably pertinent to the inventor's problem.⁷ McDonald deals with the problem of providing a fiberglass building for use in toxic or corrosive conditions. See Summary of the Invention. This field of reference is not reasonably pertinent to the problem addressed by Applicant's invention, which is that of providing a door and frame for an air-handling unit with high structural strength and more efficient thermal properties. See Background of the Invention. A person of ordinary skill in the art of doors for air handling units simply would not find McDonald reasonably pertinent to his problem. The simple, fiberglass door of McDonald would not be usable in air handling units because it would not have the structural strength needed by such doors, as set forth in the Background of the Invention. See also U.S. Patent No. 3,818, 655, col. 2, lines 25-55 (air handling unit constructed of steel plate).

Ryan is non-analogous prior art. The reference is not within the field of the inventor's endeavor.⁸ Applicant's field of endeavor is doors for air handling units. Air handling units are classified by the Office in U.S. Class 52, subclass 79, as exemplified by U.S. Patent No. 3,818,655. PTO Classification is some evidence of analogousness.⁹ Ryan is classified in U.S. Class 49, subclass 498.1. Ryan's field of endeavor is gaskets for rail cars. See Field of Invention, Description of Related Prior Art. The test for analogous art outside an inventor's field of endeavor is whether the art pertains to the particular problem confronting the inventor.¹⁰ In these situations, the law presumes knowledge only of those arts reasonably pertinent to the inventor's problem.¹¹ Ryan deals with the problem of providing a gasket for use in rail cars. This field of reference is not reasonably pertinent to the problem addressed by Applicant's invention, which is that of providing a door and frame for an air-handling unit with high structural strength and more efficient thermal properties. See Background of the Invention. A person of ordinary skill in the art of doors for air handling units simply would not find Ryan reasonably pertinent to his problem.

⁶*In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

⁷*Id.*

⁸*In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

⁹ *Id.*

¹⁰*In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

¹¹*Id.*

- (c) The Office Action rejected claims 5 and 12 under 35 USC § 103 as being unpatentable over McDonald in view of Ryan and further in view of Guillon. Applicant traverses the rejection.

Guillon is non-analogous prior art. The reference is not within the field of the inventor's endeavor.¹² Applicant's field of endeavor is doors for air handling units. Air handling units are classified by the Office in U.S. Class 52, subclass 79, as exemplified by U.S. Patent No. 3,818,655. PTO Classification is some evidence of analogousness.¹³ Guillon is classified in U.S. Class 49, subclass 441. Guillon's field of endeavor is window slideways. The test for analogous art outside an inventor's field of endeavor is whether the art pertains to the particular problem confronting the inventor.¹⁴ In these situations, the law presumes knowledge only of those arts reasonably pertinent to the inventor's problem.¹⁵ Guillon deals with the problem of providing a sealing and guiding device for surfaces which may move relative to one another. This field of reference is not reasonably pertinent to the problem addressed by Applicant's invention, which is that of providing a door and frame for an air-handling unit with high structural strength and more efficient thermal properties. See Background of the Invention. A person of ordinary skill in the art of doors for air handling units simply would not find Guillon reasonably pertinent to his problem.

- (d) The Office Action rejected claims 16-20 under 35 USC § 103 as being unpatentable over McDonald in view of Ryan and further in view of Guillon. Applicant traverses the rejection.

Claims 16-20 are allowable for the reasons given above.

¹²*In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

¹³ *Id.*


¹⁴*In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

¹⁵*Id.*

In view of the above, allowance of all claims is respectfully requested. Issuance of the formal Notice of Allowance is earnestly solicited.

Respectfully submitted,

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Version With Markings to Show Changes Made

In the Claims:

Claims 6, 7, 13, 14, and 18 have been amended as follows:

6. The door and frame combination of claim 1, further comprising thermal pockets [on] in the door and on the frame, the thermal pockets being filled with a second insulating material.

7. The door and frame combination of claim 6, wherein the second insulating material is high-density polyurethane.

13. The door and frame combination of claim 9, further comprising thermal pockets [on] in the door and on the frame, the thermal pockets being filled with a second insulating material.

14. The door and frame combination of claim 13, wherein the second insulating material is high-density polyurethane.

18. The door and frame combination of claim 16, further comprising thermal pockets [on] in the door and frame, the thermal pockets being filled with high-density polyurethane.